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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,708	09/18/2003	Steven T. Brentano	GP107-03.DV1	6892
21365 7590 04/04/2007 GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE Mail Stop #1 / Patent Dept. SAN DIEGO, CA 92121			EXAMINER SWITZER, JULIET CAROLINE	
			ART UNIT	PAPER NUMBER
			1634	
			NOTIFICATION DATE	DELIVERY MODE
			04/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdept@gen-probe.com
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**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/665,708	Applicant(s) BRENTANO ET AL.	
Examiner Juliet C. Switzer	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 13-20.
Claim(s) withdrawn from consideration: 1-12.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 11. does NOT place the application in condition for allowance because: Regarding the 102 rejection, applicant states that interpreting claim 16 as "open" with regard to the sequence limitations is not using the "plain meaning" of the claim. Applicant states that "kit" was known at the time of the invention to be "a packaged collection of related material." Definitions of "kit" also include a group of persons or things, a collection of articles usually for personal use. The word kit is broadly and reasonably interpreted as being a collection, in this case, a collection of oligonucleotides. There is no requirement implicit or inherent in the "kit" that it be packaged. The claim does not require that the oligonucleotides be in separate containers, etc. The examiner reasonably interprets claim 16 as a kit (group of things) that contains (comprises, includes) one or more oligonucleotides (nucleic acid molecules of more than one nucleotide) selected from SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 23, and SEQ ID NO: 24. The GenBank record provides an oligonucleotide that contains the sequences. There is no transitional language to precede the recitation of the Markush group that defines the oligonucleotides, and so a reasonable interpretation of this language includes an open interpretation. This is distinguished from Crish because at least in Crish the applicant was clear about the transitional language used to define the "segment." Here there is no clear transitional language to limit the length of the oligonucleotides. The rejection is maintained. Amendment of claim 16 to recite clear transitional language defining the oligonucleotides would overcome this 102 rejection. For example, A kit containing one or more oligonucleotides, wherein said oligonucleotides consist of a sequence selected from the group consisting of SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 23, and SEQ ID NO: 24 would overcome the 102 rejection. Possible 103 considerations would remain.

The remark regarding the 103 rejection rely on the Rule 132 declaration filed with the after-final amendment. The declaration was not entered because it was not timely filed.

Applicant states that the response to remarks in the final office action included many conclusions about Buck et al. that were not supported and requested the examiner to provide a reference or an affidavit to support the positions. Buck et al. is an example of the state of the art at the time the invention was made. Further, Hogan et al. (as discussed in the withdrawn 103) discussed selecting primers to target regions that would not have hinderances to amplification. These together show that this was routine practice. The second statement is pointing to applicant's suggestion that the practice of trimming raw data is not routinely practiced in the technology. The examiner merely pointed out that this was attorney argument. Applicant points out that McAllister et al. do not disclose the particular claimed compositions, and that the GenBank reference does not identify, select, or otherwise point out the oligonucleotide sequences claimed in this application. This is agreed. The Buck reference is cited to demonstrate that primers selected from throughout a nucleotide sequence would be capable of PRIMING and extension reaction, and thus, absent a secondary consideration the selection of any and all oligonucleotides for priming the sequence taught by the GenBank record would have been obvious.

The evidence in the declaration has not been considered.

The rejections are maintained.


JULIET C. SWITZER
PRIMARY EXAMINER